

A circular stamp with a double-line border. The outer ring contains the text "U.S. PATENT & TRADEMARK OFFICE" at the top and "FEB 25 2003" at the bottom. The inner circle contains "OIF" at the top and "DOC" at the bottom, with a small "J" positioned between them.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Scott A. Waldman, *et al.*

Serial No.: 09/820,215

Group Art Unit: 1637

Filed: March 27, 2001

Examiner: **Alexander H. Spiegler**

For: HIGH SPECIFICITY MARKER DETECTION

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DATE OF DEPOSIT: **February 25, 2003**

Assistant Commissioner for Patents
Washington, D.C. 20231

**REPLY UNDER 37 C.F.R. § 1.143 TO
OFFICE ACTION DATED SEPTEMBER 26, 2002**

Reconsideration of the requirement for restriction is respectfully requested in view of the following remarks.

Restriction Requirement

A restriction has been required under 35 U.S.C. § 121 to one of four groups of inventions, characterized as Groups I to IV. The claims and the subject matter said to be associated with each group are set forth below.

Group I, encompassing claims 1-15 and 32, drawn to methods of detecting the presence of a disseminated cell marker;

Group II, encompassing claims 16-30, drawn to methods of diagnosing metastatic cancer:

Group III, encompassing claim 31, drawn to a method of detecting the presence of a tissue-specific marker in a sample not associated with the tissue-specific marker; and

Group IV, encompassing claims 33-36, drawn to kits comprising an affinity column and primers.

The Office Action asserts that the inventions of Groups I to IV are patentably distinct.

Applicants respectfully traverse the restriction requirement as it applies to Groups I and III.

Applicants respectfully request the Examiner to consider reconfiguring the restriction requirement so that the subject matter of Groups I and III is contained within a single group. The methods defined by independent claim 31 are a specific embodiment of the methods defined by claim 1. Accordingly, Applicants respectfully submit that the relationship among the subject matter defined by the present claims is such that a reasonable search of the methods defined by the claims of Group I would necessarily lead to disclosures, to the extent any exist, of the methods defined by the claim of Group III. Accordingly, Applicants respectfully submit that a search and examination of the subject matter encompassed by the claims of Groups I and III would not impose a serious burden on the Examiner.

In accordance with 37 CFR 1.143, applicants hereby provisionally elect for prosecution the subject matter of Group I, encompassing claims 1-15 and 32, and drawn to methods of detecting the presence of a disseminated cell marker.

Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable Action is respectfully requested.

Respectfully submitted,



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